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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/018,104    02/03/98    HOBART

J    PHAN-00100

EXAMINER
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QM12/0917

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ART UNIT	PAPER NUMBER

3739

DATE MAILED:

09/17/01

*24*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/018,104

Applicant(s)

Hobart

Examiner

d. shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on July 27, 2001 & August 10, 2001
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14, 17-24 & 41-49 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14, 17-24, & 41-49 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 23
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 41-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed disclosure is silent on the lasers producing the same wavelength. *dr*

Claims 2-5, 11-14, 17-23, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 49 exactly <sup>*what*</sup> is to be encompassed by the term "arm feature" is unclear. Claims 11 and 17 are indefinite as the meaning of the term "two or more lasers which are combined in an alternating pattern" is unclear. For the purposes of examination, <sup>*is*</sup> the term will be *dr* reads as -- two or more lasers each producing laser beams --. Claims 11 and 17 are further indefinite because it is unclear how the beams are combined "in an alternating fashion" wherein "a plurality of coagulative laser" pulses are generated and "delivered in sequence to a target area"

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 11, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dwyer et al.

Claims 1-3, 6-8, 11-14, 17-19, and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al, Belkin et al and Dwyer et al. Sklar et al teach a laser system including multiple lasers with a graphical interface and teach that it can be used for any type of surgery with any type of laser and that the depth of the laser action can be input and displayed. Dew ('969) teaches the use of a carbon dioxide laser operating at 10.6 microns as a cutting laser in a laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue. Belkin et al teach that carbon dioxide lasers operating 10.6 microns can be used to heat, rather than cut tissue. Anderson et al teach the way parameters such as absorptivity spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. Dwyer et al teach performing surgery by alternating cutting and coagulation. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser as taught by Dew ('969) in the graphical user interface of Sklar et al, since this is to be used with any laser, as taught by Sklar et al, to also configure the laser to coagulate as taught by Belkin et al, since this would render the device more versatile, at no extra cost and to employ the particular laser parameters claimed since these provide no unexpected result., and are within the scope of one having ordinary skill in the art as

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*to alternate*  
shown to by Anderson et al cutting and coagulating pulses, since this enables bloodless surgery, *as*  
as taught by Dwyer et al; employ an articulated arm, since these are notorious in the art for  
transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which  
has already taken and to use a galvanometer to alternate the beams, since <sup>ese</sup> ~~the~~ are notorious for *in*  
moving optical components official notice <sup>is,</sup> which hereby taken thus producing a device such as  
claimed.

Claims 4, 5, 9, 10, 20-24 and 42 are rejected under 35 U.S.C. 103(a) as being  
unpatentable over Sklar et al in combination with Dew (969), Anderson et al, Belkin et al and  
Dwyer et al as applied to claims 1-3, 6-8, 11-14, 17-19, 41 and 43-49 above, and further in view  
of Assa et al. Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and  
Erbrium YAG lasers. Thus it would have been obvious to the artisan or ordinary skill to employ  
an handpiece as taught by Assa et al, since this allows more consistency of treatment and to  
employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a  
device such as claimed.

Applicant asserts that the use of two lasers of the same type will result in the output  
beam being a single wavelength. The examiner must disagree, noting the Dwyer et al use the  
same type of laser to produce different wavelengths.

To extent that applicant argues the reference teachings, they are argued separately without  
regard to what the combination would teach one having ordinary skill in the art.

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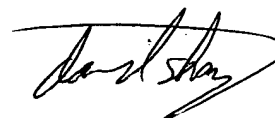
Applicant's arguments with respect to claims 1-14, 17-24 and 41-49 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
August 30, 2001



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330